

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT MITCHELL BLANKENSHIP
and
JAMES KEITH BARDMAN

Appeal No. 2004-1923
Application No. 09/789,388

ON BRIEF

Before PAK, WALTZ, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2002) from the examiner's final rejection of claim 9 (final Office action mailed Jan. 23, 2002, paper 7), which is the only claim pending in the above-identified application.

The subject matter on appeal relates to an aqueous polymer emulsion. According to the appellants (specification, pages 1-2), the polymer particles in the emulsion are voided or hollow

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and are often used in paints, coatings, inks, sunscreens, and paper manufacture. Further details of this appealed subject matter are recited in claim 9 reproduced below:

9. An aqueous polymer emulsion comprising water and swollen multi-stage emulsion polymer wherein the dry bulk density of the swollen multi-stage emulsion is: less than 0.77 g/cc when the swollen multi-stage emulsion polymer has a particle size below 275 nm; less than 0.74 g/cc when the swollen multi-stage emulsion polymer has a particle size of from 275 to 500 nm; less than 0.59 g/cc when the swollen multi-stage emulsion polymer has a particle size of from 501 to 750 nm; less than 0.46 g/cc when the swollen multi-stage emulsion polymer has a particle size of from 751 to 1300 nm.

The examiner relies on the following prior art references as evidence of unpatentability:

Kowalski et al. (Kowalski)	4,469,825	Sep. 04, 1984
Blankenship et al. (Blankenship)	4,594,363	Jun. 10, 1986

Claim 9 on appeal stands rejected under 35 U.S.C. § 102(b) as anticipated by Blankenship or Kowalski. (Examiner's answer mailed Sep. 17, 2002, paper 13, pages 4-6; supplemental examiner's answer mailed Sep. 9, 2003, paper 18, pages 3-6.)

We affirm.

Prior to addressing the merits of the examiner's rejections, we consider the meaning of certain terms appearing

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in the appealed claim. The term "dry bulk density" is defined as the value obtained from a specific procedure. (Specification pages 26-28.) The term "particle size" refers to an average particle size measured using Brookhaven BI-90. (Id. at 28.) It is clear, therefore, that the specified conditional properties for the swollen multi-stage emulsion polymer are recited in the alternative.

Like the appellants, Blankenship describes an aqueous polymer emulsion comprising water and swollen multi-stage emulsion polymer particles containing voids. (Column 5, lines 19-33; column 6, line 63 to column 7, line 14.) In Examples 2-A and 2-B, Blankenship describes swollen emulsion polymers having an average particle size of 0.5 micron (500 nm) and a void size of 0.35-0.4 micron.

Similarly, Kowalski discloses an aqueous polymer emulsion comprising water and swollen multi-stage emulsion polymer particles containing voids. (Column 7, lines 33-48; column 8, line 63 to column 8, line 14.) In Example 2, Kowalski teaches swollen emulsion polymers having a weight average diameter of 329 nm and a void diameter of "around 150 nm."

Given that each of the relied upon references teaches swollen multi-stage emulsion polymers having high void volume,

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it would reasonably appear that the prior art emulsion polymers would inherently or necessarily possess the characteristic (i.e., "less than 0.74 g/cc when the swollen multi-stage emulsion polymer has a particle size of from 275 to 500 nm") recited in the appealed claim. On this point, it is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed in the prior art, the burden of proof is on the applicants to prove that the prior art product does not inherently or necessarily possess the characteristics attributed to the claimed product. See, e.g., In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

Under these circumstances, we share the examiner's view that Blankenship or Kowalski discloses, either explicitly or inherently, every limitation of the invention recited in appealed claim 9. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

The appellants argue that the examiner's rejections are in error because neither Blankenship nor Kowalski is an enabling

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reference.¹ (Appeal brief filed Jul. 15, 2002, paper 12, pages 5-12; reply brief filed Nov. 6, 2002, pages 2-7.) In support of this position, the appellants rely on the 37 CFR § 1.132 (2003) (effective Nov. 29, 2000) declaration of Robert Blankenship, one of the inventors in the present application.

The appellants' position is without merit. "It is well settled that prior art under 35 U.S.C. § 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it." In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). While "failures by those skilled in the art (having possession of the information disclosed by the publication) are strong evidence that the disclosure of the publication was nonenabling" (id.), the appellants have an uphill climb to establish non-enablement as to either Blankenship or Kowalski, because the presumption of validity of a United States patent under 35 U.S.C. § 282 (2003) applies even in the context of patent prosecution. Cf. In re Spence, 261 F.2d 244, 246, 120 USPQ 82, 83 (CCPA 1958).

¹ Facially, both the Blankenship and Kowalski patents are assigned to the real party in interest of the present application.

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Regarding the Blankenship patent, the declaration alleges that Example 1-C/2-B was duplicated. (Declaration at 2-3.) According to the declaration, the resulting swollen multi-stage emulsion polymers had an average particle size of 855 nm and a "dry density" of 0.7835 g/cc, which is outside the scope of appealed claim 9.

We are not persuaded. The Blankenship patent discloses the swollen multi-stage polymer to have an average particle size of 500 nm (not 855 nm as reported in the declaration) and a void size of 0.35-0.4 micron (350-400 nm).² Thus, the exemplified prior art particles possess high void content (70-80%), which would necessarily result in low dry bulk density. Additionally, in the appealed claim, a broader range of dry bulk density is possible at a relatively small average particle size. That is, at an average particle size of 500 nm, the recited range of dry bulk density is significantly broader than that at 855 nm.

While an indirect showing may, in some circumstances, be sufficient to show that a prior art product differs from a claimed product, the proffered declaration does not explain why

² Appealed claim 9 recites that when the average particle size is from 275-500 nm, the dry bulk density may be "less than 0.74 g/cc."

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the average particle size of the reproduced polymer deviated from that reported in Blankenship. Also, the declaration lacks any discussion as to the void size of the reproduced polymer particles. Thus, it is impossible to determine the probative value of the proffered evidence as an indirect showing.

Regarding Kowalski, the declarant states: "[W]e were unable to prepare particles with low dry bulk density as in Example 2 of this patent." (Declaration at 2; underscoring added.)

According to the declaration (id.), "[t]he 60% active quaternary ammonium cationic surfactant used in the original example...is no longer commercially available" (emphasis added) and, therefore, three other "similar quaternary ammonium cationic surfactants" were substituted for the "60% active quaternary ammonium cationic surfactant" but these substitute surfactants resulted in failed experiments.

Again, the evidence is insufficient. The declaration merely states that the 60% active quaternary ammonium cationic surfactant used in Kowalski's original example is "no longer commercially available." There is no evidence to indicate that one of ordinary skill in the art could not synthesize the same 60% active quaternary ammonium cationic surfactant described in Kowalski. Moreover, the declaration is silent on whether the

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substitute cationic surfactants are in fact 60% active as in Kowalski's example. Accordingly, the declaration evidence falls short of establishing that Kowalski does not "sufficiently describe the claimed invention to have placed the public in possession of it."

For these reasons and those set forth in the answer, we affirm the examiner's rejections under 35 U.S.C. § 102(b) of appealed claim 9 as anticipated by Blankenship or Kowalski.

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

Chung K. Pak)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Thomas A. Waltz)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Romulo H. Delmendo)	
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